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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/892,681

06/27/2001

Michael D. Rosenzweig

INTL-0597-US (P11773)

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06/05/2006

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EXAMINER

DEANE JR, WILLIAM J

ART UNIT

PAPER NUMBER

2614

DATE MAILED: 06/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/892,681

Applicant(s)

ROSENZWEIG, MICHAEL D.

Examiner

William J. Deane

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,6,8,9,12-16,18-27 and 30-38 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) -2,5-6,8-9,12-16,18-27 and 30-38

is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 2, 5 – 6, 8 - 9, 12 – 16 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application No. 20010046304 (Rast).

With respect to claims 1 - 2, 8 – 9, 12 – 16 and 18, note Paragraphs 0007, 0009, 0010, 0013, 0015, 0017, 0022, 0025, 0049, 0052, 0056 – 0057, 0059 and 0061.

With respect to claim 5, note element 24.

With respect to claim 6, note Fig. 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19 – 27 and 30 - 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over f U.S. Patent Application No 2002/0013784 (Swanson) in view of Rast.

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With respect to claims 19 – 20, 23, 26 and 37, note that Rast can connect to a phone (see paragraph 0019). However, it is unclear as to whether one can actually communicate (talk to a caller) or one can just hear the ringing and then must take off the headset and then to proceed to use the phone.

Note that Swanson teaches a portable device comprising a sensor to sense an audio signal and a control unit; such are inherent in 3G phone 64. The storage unit could be the user's PC or at the service provider (Paragraphs 0024 and 0028). Also note storage units in Rast. It would have been obvious to incorporate the noise reduction elements of the headset as taught by Rast into the telephone of Swanson in order to have better communication quality.

With respect to claim 21, note Paragraphs 0004, 0006 and 0042 of Swanson.

With respect to claim 22, note Paragraph 0007 of Rast.

With respect claim 24, anything is removable.

With respect to claim 25, it would have been obvious to one of ordinary skill in the art to use multiple sensors as such would only be duplicative of what is known in the art.

With respect to claim 27, note Paragraph 0053 of Rast.

With respect to claim 30, note the phone of Swanson.

With respect o claims 31 and 34, note Paragraph 0053 of Rast.

With respect to claim 32, note the paragraphs recite with respect to Rast above.

With respect to claim 36, note Rast and the Abstract of Swanson.

With respect to claims 35 and 38, note Paragraph 0018 of Rast.

With respect to claim 33, cell phones have displays to view video from the Internet (note use of Internet in Rast and Swanson and their respective displays). Though neither expressly discloses "video", it appears that both can obtain video and if the video has sound that would be the second signal. Even if this was argued, music videos are old in the art and it would have been obvious to one of ordinary skill to incorporate such ability (if not already inherent in both) into either the Rast or Swanson devices.

Response to Arguments

Applicant's arguments filed 03/10/2006 have been fully considered but are not deemed persuasive to any error in the rejection above.

First, applicant argues that Rast only teaches audio data are stored selection criterion corresponding to triggers of particular sounds in an ambient environment. However, such is not the case (see paragraph 0022). Applicant further argues that there is no mixing of signals to produce a combined signal to the speakers. However, the idea of Rast is allow a person to listen to music, but be able to hear certain sounds from the environment if that sound matches a sound that was pre-selected by the user, for example, a phone ringing. Note that the user has control over both the attenuation (see paragraph 52) and volume (see paragraph 59). Obviously, the signals are mixed. That is, one can hear the music and the matched hearthrough signal. In addition, note paragraph 57. Additionally, note that the headset of Rast, in paragraph 0061, actually uses the word "mixes the incoming audio signal with ambient sounds". It all depends on how one programs the device (see Table 1 of Rast).

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With respect to claims 19 – 27 and 30 – 38, applicant argues that the storage medium is in a PC and not a phone. One of ordinary skill in the art would understand that today a PC is a phone and a phone is a PC.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bill Deane whose telephone number is (571) 272-7484. In addition, facsimile transmissions should be directed to Bill Deane at facsimile number (571) 273-8300.

21May2006


WILLIAM J. DEANE, JR.
PRIMARY EXAMINER